

The prosecution history and details are as follows: A first Office Action was mailed on 10/13/2004 rejecting all of the claims under §112, ¶2, for indefiniteness and requesting structure, chemical name and CAS number of the compound "isodiphenyl phosphate". This §112 rejection was the only rejection presented in the first Office Action. Applicant filed a Response on 1/10/2005, providing the requested information on the compound and further requesting clarification from the Examiner as to what was meant by the comments in the rejection concerning the term "High", while at the same time providing evidence that the term was defined and supported in the specification as filed.

While certain of the claims were amended in the Response of 1/10/2005, those amendments were directed to issues other than the §112 rejection and were not made for substantive reasons related to patentability but rather to clarify a particular term and a method in the claims.

The current Office Action presents an entirely new ground for rejection, a §102 rejection based upon newly cited prior art. The Office Action states that "Applicant's [arguments] do not overcome prior art use of the now understood IDPP...." However, Applicant respectfully points out that he did not provide any arguments to overcome prior art use; in fact, it was impossible for Applicant to have provided any arguments to overcome prior art use *when no prior art whatever was cited* in the first Office Action.

The first paragraph of MPEP 706.07 states that:

Before final rejection is in order **a clear issue should be developed** between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed **should be thoroughly searched in the first action and the references fully applied**. [emphasis added]

Clearly, this did not take place. No search whatever, let alone a thorough search, was carried out by the Examiner, as evidenced by the fact that no Notice of References Cited (PTO-892) was forwarded by the Examiner with the first Office Action. And, in fact, in the first Office Action the examiner was requesting clarification of the identity of the compound in the claims so that he could carry out a search. And certainly, no references were "fully applied" since no references whatever were cited in rejecting the claims. As the MPEP further states, at 706.07 (second and third paragraphs):

"... present practice does not sanction hasty and ill-considered final rejections. The Applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. ...

The examiner should never lose sight of the fact that in every case the applicant is entitled to a **full and fair** hearing, and that **a clear issue between applicant and examiner should be developed....**" [emphasis added]

While second actions may be made final under present patent office practice, there are exceptions. MPEP 706.07(a) states that second actions "... **on the merits** shall be final, **except where** the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)...." [emphasis added]. None of the requirements set forth in the MPEP for making the present rejection final is present in this case.

The only amendments made to the claims by Applicant were made merely for purposes of clarification and consistency (that is, changing "ingredient" to "agent" in claim 1 for consistency with the other claims, and adding a method step to claim 11 to clarify the claimed invention). The amendments were not made in response to the 112 rejection in the first Office Action, nor for any substantive reasons related to patentability. The new ground for rejection (a 102 prior art rejection) in the current Office Action was clearly **not** necessitated by the amendments.

Further, the new ground for rejection was **not** based on an IDS filed under 37 CFR 1.97(c) for the simple fact that no such IDS has been filed.

As further stated in MPEP 706.07(a) in support of Applicant's position:

A second ... action **on the merits** ... should **not** be made final if it includes a rejection, **on prior art not of record**, of any claim amended to include limitations which should reasonably have been expected to be claimed. ... For example, one would reasonably expect that a rejection under 35 USC 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element. [emphasis added]

This directive is pertinent to Applicant's clarification of the compound IDPP provided in response to the previous Office Action. Applicant should be allowed to provide the required information which should reasonably have been expected to be claimed, without

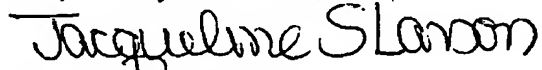
receiving a next, *final* Office Action that includes a rejection on prior art that was not previously of record.

CONCLUSION

In view of the foregoing, it is respectfully requested that the finality of the Office Action mailed 05/04/2005 be removed.

The present paper is submitted solely for the purpose of requesting reconsideration as to the propriety of the finality of the Office Action. Response to the substantive rejections in the Office Action will be timely filed at a later date.

Respectfully submitted,


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